

HAEBERLI  
Application No.: 09/560,222  
Page 4

PATENT

### REMARKS

Applicants take this opportunity to thank the Examiner for the interview of November 26, 2003. The claim discussed was claim 112, and based on the Examiner's statement that claim 112 (and not claim 117 as stated in the Examiner's interview summary mailed 12/1/2003) was very broad, Applicants have rewritten the independent claim 112 to provide a fresh start. Applicants note that since the claims no longer recite "suggesting by a computer", any prior comments thereto are inapplicable.

In light of the new claim 112 recital, Applicants respectfully traverse the rejections and respectfully submit that all claims are in condition for allowance.

The Final Office Action rejected claims 112-114 and 136 under Section 102(e) as anticipated by Enomoto (5,974,401). Further, claims 115 and 117-135 were rejected as unpatentable over Enomoto in view of Official Notice. Claim 116 was rejected under Section 103(a) as unpatentable over Enomoto and Wain (6,298,197). Each rejection will be addressed in depth below.

#### The §102 Rejections

Claims 112-114 and 136 were rejected under Section 102(e) as anticipated by Enomoto. Enomoto relates to a digital print order and delivery method and system where an order sender processes the image data with reference to a display on the screen of a computer, and then inputs print order data. The print order data includes print option data designating size and number of prints, expected delivery date data, delivery option data designating the way of delivery, and user ID data for identifying the order sender. Then an order receiver or a particular photofinisher is designated. The processed digital image data and the print order data are sent to the designated photofinisher for printing.

Enomoto requires a user to operates a computer to perform the tasks of editing and ordering prints as follows:

Now the operation of the above embodiment will be described with reference to FIG. 3. The user 10 gets the list of photofinishers 25 on-line through the network 23 such as the Internet. The list 25 is obtainable by use of data communication software attached to the personal computer 11. Next, the user 10 selects the best photofinisher 12 from the list 25 taking into account which store is the nearest, what kind of print format is expected, how much the charge for print is, and what kind of delivery is possible, etc., and then taps into the Web site of the selected photofinisher 12 to connect to the data base 24 on the photofinisher side 12.

HAEBERLI

Application No.: 09/560,222

PATENT

Page 5

Upon user's request for downloading sent from the connected personal computer 11 on the user side 10, the work station 13 of the photofinisher 12 sends out the image processing-ordering software to the personal computer 11 of the user side 10. The user 10 extracts the downloaded image processing-ordering software and installs it in the personal computer 11. If the installation is accomplished normally, a user registration menu appears, which helps the user register for the print order.

In this user registration processing, the work station 13 publishes a user ID number and a password for the user 10. After that, the work station 13 can receive a print order just by checking these user ID number and password.

Next, the user 10 takes in the image data for print and carries out the image processing by using the image processing-ordering software. The image data is input into the personal computer 11 by the scanner 20, digital still camera and digital video camera without illustration. In addition, television images and video tape recorder images are input through a video capture board. Moreover, the image from the network 23 such as the Internet may be taken in as image data for print, if it is allowed to be printed.

The image data taken in is processed by the image processing-ordering software. Among the image processing techniques, for instance, there are gamma-correction, matrix correction, illustration-letter composition, magnification/reduction processing, trimming and image composition. After the image processing is complete, the processed image data is compressed, for example, by JPEG (Joint Photographic Experts Group) compression. The compressed image data is written in the fixed area of RAM of the personal computer 10. Not only JPEG, but also other well-known type data compression method are applicable.

Next, the user inputs the print order data. It is carried out through selecting the expected option data on the data input screen by using a mouse or a keyboard. After the input of all print order data is accomplished, the computer 11 of the user 10 moves to a data transfer mode, then it is connected to the work station 13 of the photofinisher 12 and a print pre-order data is sent through the data communication.

The print pre-order data consists of the print option data, the expected delivery date designation data and data of image data size or data quantity. These data pieces are included in the print order data.

Since the total number of presently accepted orders and the delivery dates thereof are managed in the work station 13, it is possible to calculate the earliest possible delivery date and the charge for the ordered prints according to the image data size and the number of prints designated by the pre-order data from the user 10 taking into account of the number of orders from other users and the processing ability or capacity of the photofinisher side 12. The delivery date and the charge calculated based on the pre-order data are sent with an accept number to the user side 10. That is, the work station 13 checks whether the delivery will be in time for the expected delivery date or not with reference to the pre-order data, and also calculates the time necessary for photofinishing the ordered prints. By adding the time taken for photofinishing to the time taken for delivery, the earliest possible delivery date is calculated.

If the calculated delivery date exceeds the expected delivery date, the work station 13 sends a message of unacceptance to the personal computer 11 of the user 10. In that case, the user 10 may change the expected delivery date and send the pre-order again, or may cancel the order.

If the calculated delivery date is within the expected delivery date, the work station 13 sends the accept number and a message of acceptance to the personal computer 11 on the

HAEBERLI

Application No.: 09/560,222

PATENT

Page 6

user side 10. The work station 13 also requires the personal computer 11 to forward the entire print order data.

The user 10 selects or designates the order execution after confirming the delivery date and the charge on the screen, then the personal computer 11 sends the entire print order data to the work station 13. The entire print order data is constituted of all the print order data and the image data for print. The work station 13 controls the entire print order data based on the accept number, and stores it into the memory device 14.

The work station 13 makes prints in the order of delivery date based on the received print order data. At this time, the work station 13 selects one printer from the printers 15 to 17 based on the print option data, and makes prints based on the designated number of prints and print size. For instance, if the normal L size is designated, the printer 15 is selected to make L size prints 33. If the cabinet size is designated, the printer 16 is selected to make cabinet size prints 35. If the A3 size is designated, the ink jet printer 17 is selected to make A3 size prints 36. If the manual correction by operator is selected, the work station 13 selects a manual print processing within business hours, and does not carry out auto-printing. In this case, the operator carries out the image processing to provide the best density and color balance, then makes the prints 33, 35 or 36 by using the printer 15, 16 or 17. Also when those print sizes and print formats which are not available by auto-printing are selected, the manual print processing is carried out by the operator within business hours. Enomoto at Col. 5, lines 66-Col. 7, line 40.

As shown abundantly above, Enomoto requires a user to make all decisions. In contrast, claim 112 relates to a method for automatically demonstrating a product feature associated with a plurality of image-based products, each image-based product having one or more product attributes and the claims recite

- receiving a first image from a user;
- receiving a request for a demonstration of an image-based product by the user;
- automatically selecting one of the plurality of image-based products by a computer;
- automatically selecting at least one of the product attributes for the selected image-based product; and
- automatically processing a first preview image of the selected image-based product having the selected product attributes using the image provided by the user.

Enomoto requires operations to be done manually by a user (e.g., where the user actuates one or more controls in order to select which product attributes to change and/or to select a new value for the selected attributes). In contrast, the claimed invention does not require user invention in the automatic selection of image attributes as follows:

HAEBERLI

Application No.: 09/560,222

PATENT

Page 7

As noted above, the system 100 can automatically select which product attributes to change and select new values for the selected product attributes. In one implementation shown in FIGS. 16 and 17A-17B, a user can cause the system 100 to automatically select which product attributes to change and the new values for the selected product attributes by actuating a user interface control such as a button. FIG. 16 is a flow diagram of process of causing a system 100 to automatically select which product attributes to change and the new values for the selected product attributes. First, a user interface control is displayed (block 1602). The user interface control can be any user interface element by which a user can initiate a command. Examples include a button, menu, menu item, command line, key sequence, selection box, and icon. Specification at Page 28, lines 5-14.

Here, Enomoto does not show each and every element of the claim, namely receiving a first image from a user; receiving a request for a demonstration of an image-based product by the user; automatically selecting one of the plurality of image-based products by a computer; automatically selecting at least one of the product attributes for the selected image-based product; and automatically processing a first preview image of the selected image-based product having the selected product attributes using the image provided by the user. Each of these missing element is an independent basis for traversing the Section 102 rejection. Since the independent claim is not anticipated by Enomoto, none of the dependent claims can be anticipated by Enomoto. Withdrawal of the rejection under Section 102(e) as anticipated by Enomoto is respectfully requested.

### **The §103 Rejections**

Claims 115 and 117-135 were rejected as unpatentable over Enomoto in view of Official Notice. As discussed above, Enomoto lacks all claimed features. Even with the Official Notice, there is no showing the specifics of a method for automatically demonstrating a product feature associated with a plurality of image-based products, each image-based product having one or more product attributes, comprising receiving a first image from a user; receiving a request for a demonstration of an image-based product by the user; automatically selecting one of the plurality of image-based products by a computer; automatically selecting at least one of the product attributes for the selected image-based product; and automatically processing a first preview image of the selected image-based product having the selected product attributes using the image provided by the user. Hence, the references singly or in combination cannot render independent claim and those dependent therefrom obvious.

Per MPEP 706.02(j): Contents of a 35 U.S.C. 103 Rejection

To establish a prima facie case of obviousness, three basic criteria

HAEBERLI

Application No.: 09/560,222

PATENT

Page 8

must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP Section 2144 - Section 2144.09 for examples of reasoning supporting obviousness rejections.

Applicants submit that there is no suggestion to modify Enomoto to arrive at the invention as claimed. There is no reasonable expectation of success since. Moreover, the references singly or in combination, does not teach or suggest all the claim limitations in the independent claims as well as each dependent claims. Since the teaching or suggestion to make the claimed combination and the reasonable expectation of success is not found in Enomoto, there is an inference that it came from Applicants' disclosure.

In sum, since none of the references show the claimed elements recited in the claims, Applicant submits that they cannot render obvious independent claim 112. The dependent claims are allowable since they depend from allowable independent claims.

HAEBERLI

Application No.: 09/560,222


Page 9

PATENT

CONCLUSION

Applicants respectfully submit that all claims are in condition for allowance. Withdrawal of the rejection is respectfully requested. If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

  
Bao Tran

Reg. 37,955

Tran & Associates

6768 Meadow Vista Court

San Jose, CA 95135

Tel 408-528-7490

Fax 408-528-1490